

Application No.: 09/960,487

Amendment Dated:

Reply to Office Action of: May 21, 2003

REMARKS

Applicants respectfully request reconsideration of the application, as amended, in view of the following remarks.

The present invention as set forth in **amended Claim 1** relates to a welding wire, comprising:

a wire having a wire surface; and

a deposit on the wire surface,

wherein the deposit comprises

at least one lubricating particle, and

at least one compound selected from the group consisting of (a) saturated or unsaturated, linear or branched, carboxylic acid having from 5 to 12 carbon atoms; (b) saturated or unsaturated, linear or branched, metal carboxylate having from 5 to 12 carbon atoms, and mixtures of (a) and (b);

wherein a total amount of said carboxylic acid (a), said metal carboxylate (b) or said mixture of (a) and (b) is 0.001 to 2 g per 10 kg of the wire;

and wherein the at least one lubricating particle comprises a material selected from the group consisting of molybdenum disulfide, tungsten disulfide, graphite carbon and polytetrafluoroethylene.

The rejection over JP09-122974A (JP'974) and Katono is respectfully traversed.

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JP09-122974A (JP'974) fails to disclose or suggest the specific metal soap as claimed.

Katono fails to disclose an amount of the disclosed sodium or potassium metal soaps of carboxylic acids having 5-12 carbon atoms on the surface of a wire.

In the present invention, 0.001 to 2 g per 10 kg of the wire of carboxylic acid (a), or metal carboxylate (b) as claimed ensures good wire feedability as discussed at page 23, last paragraph of the specification. The amounts of matter clogged for example in a conduit tube is at a level that presents no problem when welding is continued over a long time. This is not disclosed or suggested by JP09-122974A (JP'974) or Katono or their combination.

Further, it is believed that no *prima facie* case of obviousness exists because neither reference suggests that the embodiment of the claimed composition which requires C₅₋₁₂ metal carboxylates would work any better than similar compositions having metal carboxylates outside the claimed range. If the Office deems that *prima facie* obviousness nevertheless exists, it is believed to be obviated by the data already of record in the specification.

A review of the English translation of JP '974 shows that it appears to be closer to the claims than the Katono reference. Whereas JP '974 relates to a welding wire, Katono relates to steel which is to be formed or deep-drawn (Katono, column 1, lines 12-15). In addition, the lubricant in Katono is added so that stamping speeds in excess of 20m/min can be used in the high-speed stamp forming of metals (Katono, col. 2, lines 24-33) and not to ensure good wire feedability of a welding wire. Indeed, based on the JP '974 disclosure, the English

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translation of which was previously provided, there is no motivation to combine Katono and no expectation of success in the combination.

The JP '974 reference recites that smooth wire feeding results from a "synergistic effect" owing to the components in its coating. See, e.g., JP '974 English translation page 3, lines 3-5 from the bottom. There is no disclosure or suggestion that 0.001 to 2 g per 10 kg of the wire of carboxylic acid (a), or metal carboxylate (b) as claimed ensures good wire feedability as discussed at page 23, last paragraph of the specification.

McCune has been applied to Claims 19 and 20. However, it does not cure the defects of JP09-122974A (JP'974) or Katono et al, because it fails to disclose a total amount of said carboxylic acid (a), said metal carboxylate (b) or said mixture of (a) and (b) of 0.001 to 2 g per 10 kg of the wire, as claimed.

Therefore, the rejection of Claims 1, 4, 9, 10, 12-13 and 15-18 under 35 U.S.C. §103(a) as being unpatentable over JP09-122974A (JP'974) in view of Katono et al and the rejection of Claims 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over JP'974 in view of Katono et al and in further view of McCune (U.S. 5,976,704) are believed to be unsustainable as the present invention is neither anticipated nor obvious and withdrawal of these rejections is respectfully requested.

Further, Applicants wish to thank Examiner Jackson for indicating allowability of Claims 3, 14, 21, 22 and 23 if rewritten in independent form including all of the limitations of

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the base claim and any intervening claims.

Applicants have added new Claims 24-26. New Claim 24 includes the limitations of Claim 1 and allowable Claim 3. New Claim 25 includes the limitations of Claim 1 and allowable Claim 22. New Claim 26 includes the limitations of Claim 1 and allowable Claim 23. Thus, Claims 24-26 are allowable.

Applicants respectfully request that the Examiner acknowledge that all references cited in the **Information Disclosure Statement**, filed in the above-identified application on **September 24, 2001**, have been considered. Applicants note that the Examiner has not initialed references AD. For the Examiner's convenience, a copy of Form PTO 1449 as signed and dated by the Examiner and sent with the Office Action of February 13, 2002, is attached herewith.

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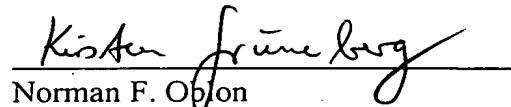
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Applicants submit that the present application is now in condition for allowance and early notice of such action is earnestly solicited.

Respectfully submitted,

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